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LM02/0830

EXAMINER

NGUYEN, C

ART UNIT

PAPER NUMBER

2764

DATE MAILED:

08/30/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/182,279

Applicant(s)

Coppersmith et al.

Examiner

Cuong H. Nguyen

Group Art Unit

2764



☒ Responsive to communication(s) filed on Jun 5, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-21 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-21 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTC 1-49, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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#### **DETAILED ACTION**

1. This Office Action is the answer to the communication (the amendment) received on 6/05/2000, which paper has been placed of record in the file.

2. Claims 1-21 are pending in this application.

#### **Response**

3. Since it may be unclear to the applicants about the way the examiner arranged the claimed rejections' structure/arrangement; the examiner withdraws previous rejections due to the applicants' explanations in the above amendment & remark; hence, the arguments are moot. Although the claims are withdrawn on 35 U.S.C. § 112 2<sup>nd</sup> para. rejections, new grounds of rejections are applied since submitted arguments are not persuasive upon new references based on 35 U.S.C. § 103(a).

4. The following rejections are based on the current examiner's broadest reasonable interpretation of the claims; *In re Pearson*, 181 USPQ 641 (CCPA 1974).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

5. Claims 1, 5-6, 8-10, 15 are rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC.

A. Referring to claim 1: It is directed to a system for verifying an authenticity of a product, comprising:

- an electronic tag attached to a product/(a product packaging), it can store authentication information in encrypted form; and a reader equipped with a decryption key for reading said authentication information from said tag (to verify said product is authentic).

The above limitations are obviously included in Gemplus product (see FUJI-KEIZAI USA, INC. pg.1, e.g. electronic tags, and GPR400, a smart card reader in PC Card format to instantly encrypt and decrypt reading data); (see also Chew (US. Pat. 5,901,303) suggests a similar application (e.g. a tag having a memory) with a microprocessor embedded in a smart card);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use a readily available information/system on the market from Gemplus since it makes a similar compact system for verifying an authenticity of a

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product (see In re **Fine** 5 USPQ2d 1596 (CFFC 1988), In re **Gershon, Goldberg, and Neiditch**, 152 USPQ 602 (CCPA 1967)).

B. Re. to claim 5: It is quite obvious to one with skills in the art to further (with the rationale for rejection in claim 1) including a reader (for authenticating a product) in front of a consumer prior to purchase of the product (see a court case for an **integration** characteristic).

C. Re. to claim 6: It is quite obvious to one with skills in the art to further (with the rationale for rejection in claim 1) including a reader for reading an electronic tag without physically contacting said tag (see FUJI-KEIZAI USA, INC. pg.1, e.g. RF/ID products from Gemplus do not need physically contacting a tag for reading information).

D. Re. to claim 8: It is very well-known to one with skills in the art to further (with the rationale for rejection in claim 1) imply that authenticating product information is directed to a product 's manufacturer (e.g. a company names "Sony").

E. Re. to claim 9: It is very well-known to one with skills in the art to further (with the rationale for rejection in claim 1) indicate that authentication information is specific to a product (e.g. a product serial number).

F. Re. to claim 10: It is very well-known to one with skills in the art to further (with the rationale for rejection in claim 1) including a label having authentication information printed thereon to be verified against the authentication information read by a reader (e.g. a product serial number).

G. Re. to claim 18: This claim has a similar limitation as claim 10 although it is a method claim; hence, the same rationale is incorporated.

H. Re. to claim 15: It is obvious to one with skills in the art (with the rationale for rejection in claim 1) to have authentication information including information for authenticating an electronic tag (e.g. an analogous application is the BIOS file in a PC with information about a configuration of that PC -embedded information-, see a court case for an **integration** characteristic).

In summary, the same analysis and reasoning set forth in the rejection of claim 1 are applied to these claims also because they are directed to a system that comprises similar means with very obvious limitations.

6. Claim 2 is directed to a system for verifying an authenticity of a product, wherein a tag is a smart card (see FUJI-KEIZAI USA, INC. pg.1, e.g. electronic tags, and GPR400, a smart card reader in PC Card format to instantly encrypt and decrypt reading

data); (see also Chew (US. Pat. 5,901,303) suggests a similar application (e.g. a tag having a memory) with a microprocessor embedded in a smart card).

7. Claim 3 is directed to a system for verifying an authenticity of a product, wherein a tag is embedded into a product/(a product packaging) (e.g. see also Storch et al. (US Pat. 5,367,148) Figs. 2-3, the rationales for rejection for claim 1 are incorporated).

8. Claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., in view of Mob (US Pat. 5,740,250).

It is directed to a system for verifying an authenticity of a product, wherein information is encrypted using a private key, and is decrypted using a public key (see '250 claims 21, and 26; the rationales for rejection for claim 1 are incorporated herein).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of Gemplus with the suggestions of Mob for verifying the authenticity of a product in a conventional way, because these information are readily available at that time.

9. Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., in view of Guillou et al. (US Pat. 5,149,634).

10. Claims 7 is directed to a system for verifying an authenticity of a product, wherein a zero-knowledge protocol is used (see at least '634 the abstract, the rationales for rejection for claim 1 are incorporated herein).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of Gemplus with the suggestions of Guillou et al. for verifying the authenticity of a product, because these information are readily available at that time, and the verifying system would be done in a conventional way.

11. Re. to claim 17: This claim has a similar limitation as claim 7 although it is a method claim; hence, the same rationale is incorporated for rejection.

12. Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., in view of Storch et al. (US Pat. 5,367,148).

A system for verifying the authenticity comprises a product serial number. The rationales for rejection for claim 1 are incorporated herein.

FUJI-KEIZAI INC.'s article fails to disclose above limitation.

However, Storch et al. show that this limitation is very well-known, see at least '148 Fig. 3).



It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of Gemplus with the suggestions of Storch et al. 's disclosure for verifying the authenticity of a product serial number, because this information is very well-known, and the verifying system would be sufficient with a product's serial number.

13. Claim 12 is rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., since it is interpreted as: A system for verifying the authenticity comprises a graphical image/indicia (of the product) (this limitation is very well-known on the market, e.g. an apple for an "Apple computer" .etc., the rationales for rejection for claim 1 are incorporated herein).

14. Claims 13, 20 are rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., in view of DiCesare et al. (US Pat. 5,971,435).

A. Re. to claim 13: It is interpreted as a system for verifying the authenticity comprises an ownership history (of the product). The rationales for rejection for claim 1 are incorporated herein.

FUJI-KEIZAI USA, INC.'s article fails to disclose above limitation.

However, DiCesare et al. show that this limitation is very well-known (see '435 4:40-56, and claim 13).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of Gemplus with the suggestions of DiCesare et al. 's disclosure for verifying the authenticity of a product, because these information are readily available at that time, and the verifying system would be sufficient with a product's past history.

B. Re. to claim 20: This claim has a similar limitation as claim 13 although it is a method claim; hence, the same rationale is incorporated.

15. Claims 14, 19 are rejected under 35 U.S.C. § 103 as being unpatentable over an article of FUJI-KEIZAI USA, INC., in view of Matyas et al. (US Pat. 5,164,988).

A. Re. to claim 14: The rationales for rejection for claim 1 are incorporated herein.

It is interpreted as a system for verifying the authenticity, wherein (authentication) information is erased after being read.

FUJI-KEIZAI USA, INC.'s article fails to disclose above limitation.

However, Matyas et al. show that this limitation is very well-known (e.g. see '988 19:25-26, and 20:2-4).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement Gemplus's system with a

suggestion of Matyas et al. for verifying the authenticity of a product, because these information are readily available at that time, and the verifying task would be known as "done" with that product.

B. Re. to claim 19: This claim has a similar limitation as claim 14 although it is a method claim; hence, the same rationale is incorporated.

16. Referring to claims 16, 21: They are rejected on obviousness reasons under 35 U.S.C. § 103(a) since limitations of these claims comprise similar claims' limitations of claims 1-15 above. The same analysis and reasoning set forth in the rejection of claims 1-15 are applied to these claims also because they are directed to a method that using similar means for verifying the authenticity of a product/(detecting product in a market) (as the system in claims 1-15) to perform claimed steps.

#### **Conclusion**

17. Claims 1-21 are rejected.

18. The attached references are considered pertinent to applicant's disclosure.

- FUJII-KEIZAI USA, INC., "Top 40 high tech companies in Europe: GEMPLUS, FRANCE: Analysis of factors/strategies for company's success, future plans and business opportunities in this industry", published on July 1997.

- Edelstone et al., "Microchip Technology - Company Report" by PRUDENTIAL SECURITIES INC., published on 11/24/1995.

- "Gemplus announces integration of GemSAFE with IBM Smart Card Security Kit" from Business Wire, p.1323, published on 10/21/1998.

- "Gemplus to showcase GemSAFE Smart Card Security Solutions at RSA Conference." from Business Wire, p.1418, published on 1/14/1999.

19. Notes:

A. The examiner submits that these claims' limitations are obvious because Gemplus, Storch et al., Deo et al., Chew and Matyas et al. need not necessarily spelled-out exactly claimed languages, because their suggestions also directed to a similar system for a clinic transaction system; their limitations are not limited to described embodiments in their inventions. It is reasonable that various modifications and variations of their systems would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of the invention. Although Gemplus, Storch et al., Deo et al., Chew and Matyas et al. inventions have been described in connection with specific preferred embodiments, it should be understood that their limitations as claimed should not be unduly limited to such specific embodiments. Having described preferred embodiments of

the present invention with reference to the accompanying drawings, it is to be understood that the present invention is not limited to the above-mentioned embodiments and that various changes and modifications can be effected therein by one skilled in the art without departing from the spirit or scope of the present invention as defined in the appended claims.

B. MPEP 2113 Product-by-Process Claims [R-1]:

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

C. About structural limitations in method claims: When considering a method claim, patentable weight is given to the structure on which the claimed process is carried out in determining the obviousness of that process; *In re Kuehl*, 177 USPQ 250 (CCPA 1973); and to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere

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claiming of a use of a particular structure, **ex parte Pfeiffer**,  
1962 C.D. 408 (1961).

D. The examiner submits that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims; therefore, arguments in the amendment are not convincing while the claims are still read-on prior arts' suggestion. See *In re Van Geuns*, 988 2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Mon.-Fri. from 7AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)305-9768.

Any response to this action should be mailed to:

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or faxed to: (703) 308-9051, (for formal communications intended for entry)

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Or: (703) 305-0040 (for informal or draft communications,  
please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II,  
2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of  
this application should be directed to the Group receptionist  
whose telephone number is (703)305-3900.



Cuong H. Nguyen  
Patent Examiner  
A.U. 2764  
August 25, 2000